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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/671,721	09/29/2003	Yuji Imaizumi	045070-5036	9270

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EXAMINER	
KOSSON, ROSANNE	

ART UNIT	PAPER NUMBER
1651	

DATE MAILED: 04/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/671,721	IMAIZUMI ET AL.	
	Examiner	Art Unit	
	Rosanne Kosson	1651	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 September 2003*.

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-23* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-23* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-10, drawn to an apparatus for measuring intracellular reactions in which the apparatus maintains colonies of cells in a non-contact state, classified in class 435, subclass 288.4.

II. Claims 11-15, drawn to an apparatus for measuring intracellular reactions in which the apparatus maintains a plurality of cells in a state of cell-to-cell contact, classified in class 435, subclass 287.1.

III. Claims 16-20, drawn to an apparatus for measuring intracellular reactions, classified in class 435, subclass 287.1.

IV. Claim 21, drawn to a method of measuring intracellular reactions, in which colonies of cells are maintained in a non-contact state, classified in class 435, subclass 173.1.

V. Claim 22, drawn to a method of measuring intracellular reactions, in which a plurality of cells are maintained in a state of cell-to-cell contact, classified in class 435, subclass 173.1.

VI. Claim 23, drawn to a method of measuring intracellular reactions, classified in class 435, subclass 173.1.

The inventions are distinct, each from the other because of the following reasons.

Group I and Group II are each drawn to a different apparatus. Group I and Group III are each drawn to a different apparatus. Group II and Group III are each drawn to a different apparatus. Although the apparatus in each case is used for measuring intracellular reactions, the apparatus of Group I has a feature that maintains colonies of cells in a state in which the colonies do not contact each other. The apparatus of Group II has a feature that it maintains a plurality of cells in a state in which the cells contact each other. The apparatus of Group III has neither of these features. Therefore, Group I and Group II are patentably distinct inventions. Group I and Group III are patentably distinct inventions. Group II and Group III are also patentably distinct inventions.

The invention of Group I and the inventions of Groups IV-VI are related as an apparatus for practicing a process and three processes, respectively. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the apparatus of Group I is not required to practice any of the methods of Groups IV-VI, because, in each method, a first fluorescence is measured from cells expressing a fluorescent fusion protein. The cells are then contacted with a fluorescent probe, and a second fluorescence is measured. No particular apparatus is required to measure fluorescence emitted from cells before and after treatment with a reagent, as any fluorometer may be used. Therefore, the inventions of Groups I and IV, Groups I and V, and Groups I and VI are distinct.

Similarly, the invention of Group II and the inventions of Groups IV-VI are related as an apparatus for practicing a process and three processes, respectively. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the apparatus of Group II is not required to practice any of the methods of Groups IV-VI, because, in each method, a first fluorescence is measured from cells expressing a fluorescent fusion protein. The cells are then contacted with a fluorescent probe, and a second fluorescence is measured. No particular apparatus is required to measure fluorescence emitted from cells before and after treatment with a reagent, as any fluorometer may be used. Therefore, the inventions of Groups II and IV, Groups II and V, and Groups II and VI are distinct.

The invention of Group III and the inventions of Groups IV-VI are related as an apparatus for practicing a process and three processes, respectively. For the reason discussed above, these inventions are distinct, because the apparatus of Group III is not required to practice any of the methods of Groups IV-VI. In each method, a first fluorescence is measured from cells expressing a fluorescent fusion protein. The cells are then contacted with a fluorescent probe, and a second fluorescence is measured. No particular apparatus is required to measure fluorescence emitted from cells before and after treatment with a reagent, as any fluorometer may be used. Therefore, the inventions of Groups III and IV, Groups III and V, and Groups III and VI are distinct.

Group IV and Group V are each drawn to a different method. Group IV and Group VI are each drawn to a different method. Group V and Group VI are each drawn to a different method. Although the method in each case is used for measuring intracellular reactions, the method of Group IV requires that colonies of cells are in a state in which the colonies do not contact each other. The method of Group V requires that a plurality of cells not contact each other. The method of Group VI has neither of these requirements. Therefore, Group IV and Group V are patentably distinct inventions. Group IV and Group VI are patentably distinct inventions. Group V and Group VI are also patentably distinct inventions.

Additionally, the search for any one group is not required for the five other groups, thereby creating an undue burden of search and examination. Burden lies not only in the search of U.S. patents, but in the search for literature and foreign patents and examination of the claim language and specification for compliance with the statutes concerning new matter, distinctness and scope of enablement. Further, the different groups have each acquired a separate status in the art, as shown in part by their different classifications. Because these inventions are distinct for the reasons given above, restriction for examination purposes as indicated is clearly proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rosanne Kosson whose telephone number is 571-272-2923. The examiner can normally be reached on Monday-Friday, 8:30-6:00, with alternate Mondays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn can be reached on 571-272-0926. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Rosanne Kosson
Examiner
Art Unit 1651

rk/2005-04-14

ROBERT A. WAX
PRIMARY EXAMINER
Art Unit 1653